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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,442	08/05/2003	Neil G. Sellars	98-40145-US-C	8282

7590 06/27/2005

Louis M. Heidelberg  
Reed Smith LLP  
2500 One Liberty Place  
1650 Market Street  
Philadelphia, PA 19103-7301

EXAMINER
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AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/634,442	SELLARS, NEIL G.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) 49-97 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-48 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 13-17, 19-21, 24-27, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 11, 12, 18, 22, 23, 28, 31 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/03/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 1-48) in the reply filed on March 8, 2005 is acknowledged. The traversal is on the ground(s) that the examination of the entire application can be made by the examiner, even though it includes claims to independent or distinct inventions, without a serious burden. This is not found persuasive because, as shown in the last Office Action of February 8, 2005, the groups have separate status in the art as shown by their different classification and recognized divergent subject matter. Therefore, the examination of the entire application would indeed be a serious burden to the examiner.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 7-10, 13-14, 19-21, 24, 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Haines (4312523).

Haines relates to a device (14) for labeling an object (10) having a periphery. The device comprises a substantially planar member having oppositely disposed first and second surfaces (figures 2 and 3), a length greater than the periphery of the object (col.

Art Unit: 1772

1, lines 50-53) and a protruding tab portion (18) for facilitating re-attachable at least partial separation of the device from the periphery of the object when said device is affixed about the periphery, printed indicia on at least one of a portion of the first and a portion of the second surfaces (figures 2 and 3), and at least one adhesive on at least a portion of the second surface (figure-3).

The device comprises at least one perforation (30) in the planar member to facilitate separation. The presence of the perforation would provide for potential tamper evidencing because, when the perforation is torn, it would provide said evidence of tampering. Also, the perforation provides for a recessed edge along its line.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4, 15-17 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haines in view of Sherwick (4324058).

Haines, as discussed above, fails to teach that the adhesive is pressure sensitive adhesive (PSA). Sherwick discloses a label device (20) comprising a planar member having a length greater than the periphery of the object (15) and has releasable pressure sensitive adhesive on its rear surface for affixing it to the object. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Sherwick's

Art Unit: 1772

teaching of using releasable PSA on the rear surface of the label device in the invention of Haines with the motivation to provide for releasably adhering the label to the object.

Further, the presence of the backing substrate (32) on the label provides for a protective member on at least one portion of the member not bearing adhesive (26).

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-4, 7-10, 13-17, 19-21, 24-27 and 29-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-31 of U.S. Patent No. 6,613,410. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the Patent'410 are directed a label having a member with length greater than the periphery of the object. However, Patent'410 teaches a first and second label portion but fails to teach a planar member. It would have been obvious to one having

Art Unit: 1772

ordinary skill in the art that the label member of Patent'410 would be planar because it is shown as such when wrapped around an object as shown in the drawings.

### ***Allowable Subject Matter***

8. Claims 5-6, 11-12, 18, 22-23, 28 and 31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest that at least a portion of the adhesive is at least partially deadened, or that the member includes a part affixed about the cap of the object.

9. Claims 33-48 are allowed.

The prior art fails to teach or suggest that the planar member having a length greater than the periphery of the object and a first edge having a different length than a second edge such that the first length is oriented at an oblique angle relative to the second length of the member.

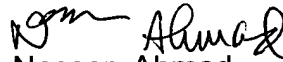
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
June 23, 2005.